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NOV 13 2008

In re Application of:	:	
Prunkard al.	:	
Application No. 09/232488	:	DECISION DISMISSING
Filing or 371(c) Date: 01/15/1999	:	PETITION UNDER
Title of Invention:	:	37 CFR 1.183
PRODUCTION OF FIBRINOGEN IN	:	
TRANSGENIC ANIMALS	:	

This Decision is in response to the Petition Under 37 C.F.R. § 1.47(a), filed August 7, 2008 to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s). The petition is properly treated under 37 CFR 1.183, to waive the requirement under 37 CFR 1.67 that all of the inventors sign a supplemental declaration. The petition fee, \$400.00, has been charged to Applicant's deposit account as authorized in the petition.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under [insert the applicable code section]"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Applicant filed the present reissue application and an Oath/Declaration on January 15, 1999. A review of Office records indicate that in a non-final Office action, mailed May 7, 2008, and in an Amendment filed August 7, 2008, in response to the on-final Office action, the Examiner and Applicant are addressing the issue of inventorship change. This Decision addresses the Supplemental Oath/Declaration only

Applicant files the present petition and reissue oath/declaration, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s). In

support of the petition, Applicant states that the nonsigning inventor, Dr. Prunkard, was provided with a copy of the original claims of the patent being reissued, the reissue claims as filed, and the currently amended claims and asked to sign the declaration now being provided. Applicant notes that Dr. Prunkard reviewed a copy of specification as related in her declaration of January 13, 1999, filed with the present reissue application on January 15, 1999.

Applicant states that in a telephone conversation with the nonsigning inventor, on August 15, 2007, Applicant informed the nonsigning inventor that a legal determination has been made she is an inventor of the current claims. Applicant thereafter sent the nonsigning inventor a copy of the claims and declaration. Applicant provides a copy of an email exchange between Applicant and Dr. Prunkard, where on August 29, 2007, Dr. Prunkard acknowledged receipt of "the fbgn paperwork," requested clarification of the claims, and stated that she wanted to sign the declaration, but needs to understand what she was signing. Applicant responded in an email dated September 4, 2007, wherein Applicant cited a copy of an email from outside counsel prosecuting the application, Joe Liebeschuetz, which included "[e]xcerpts from the patent," and reiterated to Dr. Prunkard that a legal determination has been made that she is an inventor of the currently pending reissue claims. Applicant concluded that the failure to receive either the executed declaration, or a refusal to execute the declaration by September 12, 2007 will be taken as an assumption that Dr. Prunkard has refused to execute the declaration. No response from Dr. Prunkard was received.

Applicable Law

37 CFR 1.67 states, in pertinent part:

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of §1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§§ 1.42, 1.43, or § 1.47) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires."

Analysis

Applicant's showing is deficient in that proof of the nonsigning inventor's refusal to join in the reissue application has not been established. There is no requirement for a showing under 37 CFR 1.47. This application bears an original Declaration executed by inventor Donna Prunkard, and thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand, in order to determine whether there exists an "extraordinary situation, when justice requires" waiver of the rules .

As to proof that the nonsigning inventor refuses to join in the application, the MPEP provides:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration.

MPEP 409.03(d).

In this instance, Applicant notes that Dr. Prunkard reviewed a copy of specification as related in her declaration of January 13, 1999, filed with the present reissue application on January 15, 1999. However, the claims have since been amended, thus forming the basis for the present petition. Applicant has sent a copy of the claims to Dr. Prunkard; however, Dr. Prunkard has expressed a lack of understanding as to what she was being asked to sign. More than eight (8) years has passed since the nonsigning inventor has reviewed the application.

In view of the foregoing, and absent an express refusal to join in the application, Applicant must present a copy of the application papers to the nonsigning inventor. The MPEP further provides

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

MPEP 409.03(d).

Applicant provides that copies of the claims have been provided to the nonsigning inventor; however, in view of Dr. Prunkard's expressed request for clarification, and stated desire to sign the declaration, Applicant must present a copy of the application papers to the nonsigning inventor. Applicant is cautioned that receipt of an application via email transmission must be

demonstrated by the Applicant before a petition may be granted. While receipt of an email may be confirmed by the sender, receipt of an email attachment may not be confirmed by the sender. Absent an express refusal to join in the application, Applicant must present a copy of the application papers to the nonsigning inventor.

Conclusion

The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

Absent an express refusal to join in the application, Applicant must present a copy of the application to the nonsigning inventor before a refusal to join in the application may be alleged.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
09/232,488	01/15/1999	DONNA E. PRUNKARD	PPL-1REISSUE

CONFIRMATION NO. 1781

POA ACCEPTANCE LETTER



20350
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Date Mailed: 11/12/2008

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/28/2008.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/dlwoods/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101